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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,147	07/08/2003	David W. Abraham	YOR920010260US2	8233

7590 01/21/2005  
Dr. Daniel P. Morris, Esq.  
IBM Corporation  
Intellectual Property Law Dept.  
P.O. Box 218  
Yorktown Heights, NY 10598

EXAMINER
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LE, THONG QUOC

ART UNIT	PAPER NUMBER
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2818

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,147	ABRAHAM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thong Q. Le	2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. Claims 1-60 are presented for examination.

#### *Response to Arguments*

2. Applicant's arguments filed 06/11/2004 have been fully considered but they are not persuasive.
3. The following responses to Applicant's Remarks:

Applicants respectfully disagree with the Examiner's comments that applicants' clearly are not directed to substantially the same invention as the claims of US. Pub. 2002/0089874A1.

Applicant disagrees examiner's comments. However, Applicant does not point out directed to substantially the same invention in claims of U.S. Pub. 2002/0089874A1.

Applicant is required to provide evident to prove the limitations in claims of present application is appeared in claims of U.S. Pub. 2002/0089874A1 by claim language with word by word.

Because applicant does not give any comment to show a reason the claims in present invention are substantially the same as claim invention of U.S. Pub. 2002/0089874A1. Therefore, the Response to Amendment in previous Office Action is proper and still stands.

Claims 21-40 have been objected to in under 37 CFR 1.75 as being substantially duplicate of claim 1-20. Applicants respectfully disagree. Claim 1-20 are structure or apparatus claims, and claim 21-40 are method claims. Thus claims 21-40 are not substantially duplicates of claims 1-20.

Claims 21-40 provide for the use of a method of writing, but, since the claim does not set forth any steps involved in the method/process, it is unclear what

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method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Since the claims 21-40 do not comprising any steps, examiner understands these claims such as an apparatus claims, and treated these claims as an apparatus claims. Therefore, the rejection in previous office action is proper and still stands.

Claims 1-40 have been previously rejected under 35 USC 101 as claim to the same invention of US Application No. 10/128,838, now issued as US patent 6,774,674. The claims of US 6,724,674 are not identical to claims 1-40 of the present application. Thus a double patenting rejection is not proper, applicants will submit a terminal disclaimer for the present application over US 6,724,674, when claims are allowable in the present application, if warranted.

After carefully reconsidered claims 1-40 of present application and claims 1-20 of US Application No. 10/128,838, now issued as US 6,724,674. The claims 1-20 of US 6,724,674 are clearly identical to claims 1-20 of present application.

Applicant is respectfully requested to point out the difference between claims 1-20 of US 6,724,674 and claims 1-20 of present application.

As discussed above, the rejection in previous office action is proper and still stands.

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Claims 41-60 have been rejected under 35 USC 102(b) as anticipated by Uver Wille et al, (US 4,464,437). Applicants respectfully disagree. The Examiner refers to Col.3, Claims lines 39-48 of Uver Wille et al., in which there is no teaching of applying at least one magnetic field.

Examiner respectfully disagrees as show below

loudspeaker cou). A corresponding basic unit of the write/read system consists, for example, of a laser diode 43 7, the radiation of which is focused on the layer 4 by display optics 8, so that a previously selected memory site is heated for writing information.  
By applying an external magnetic field extending in

There is a "magnetic field" in line 49, column 3. Therefore, the rejection in previous office action is proper, and still stands.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Double Patenting***

5. Claims 1-40 of this application conflict with claims 1-20 of Application No. 10/128,838. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

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6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 21-40 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

8. Claims 1-40 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 10/128,838. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

As details provided above, the claims 1-40 should be amended or canceled as required.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 41-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Urner Wille et al. (U.S. Patent No. 4,464,437).

Regarding claims 41-60, Urner Wille et al. disclose a method of writing to a magnetic memory element (Column 3, lines 39-49), the method comprising: heating the memory element; and applying at least one magnetic field to the memory element (Column 1, lines 22-42, Column 3, lines 39-54), and wherein the heat and at least one magnetic field are applied to the memory element simultaneously (Column 1, lines 30-32), and wherein heat is applied and removed before at least one magnetic field is applied to the memory element (Column 4, lines 29-41), and wherein the heating raises the temperature of the memory element by about 5 C<sup>0</sup> to 10 C<sup>0</sup> above a compensation temperature (Column 1, lines 39-52), and wherein the heating raises the temperature of the memory element (Column 1, lines 39-52), and wherein the junction is heated by passing a current through a conductor (Column 3, lines 49-54), and wherein first and second orthogonal fields (Figure 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Le whose telephone number is 571-272-1783. The examiner can normally be reached on 8:00am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David C. Nelms can be reached on 571-272-1787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Le  
Primary Examiner  
Art Unit 2818

**THONG LE**  
**PRIMARY EXAMINER**